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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* JERON WAYNE COOLMAN, DAVID RYAN PLACKO,  
9 and TUHIN GOSH  
10

11  
12 Appeal 2008-3791  
13 Application 10/747,929  
14 Technology Center 3600  
15

16  
17 Decided:<sup>1</sup> February 19, 2009  
18  
19

20 *Before* HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.  
21 FISCHETTI, *Administrative Patent Judges*.

22  
23 FETTING, *Administrative Patent Judge*.  
24

25  
26 DECISION ON APPEAL  
27

28  
STATEMENT OF THE CASE

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Jeron Wayne Coolman, David Ryan Placko, and Tuhin Gosh  
2 (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims  
3 1-20, the only claims pending in the application on appeal.

4 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
5 (2002).

6 We AFFIRM-IN-PART.

7 The Appellants invented an electronic marketplace that enables buyers  
8 to purchase items from multiple suppliers (Specification Page 3, first  
9 paragraph).

10 An understanding of the invention can be derived from a reading of  
11 exemplary claims 1, 4-6, 9, and 10, which are reproduced below [bracketed  
12 matter and some paragraphing added].

13 1. A system to support an electronic market place, comprising:  
14 [1] a communication network to communicate purchase  
15 requests;  
16 [2] one or more buyers coupled to the network to issue a  
17 purchase order specifying items from two or more suppliers;  
18 and  
19 [3] a server coupled to the network to receive the purchase  
20 order, the server accessing a Central Contract Registry (CCR)  
21 for supplier data and generating sub-orders from the purchase  
22 order and sending the sub-orders to the two or more suppliers  
23 for fulfillment and paying the suppliers based on CCR data.

24  
25 4. The system of claim 2,  
26 further comprising means for importing the CCR data  
27 into a public data storage and a private data storage.

28  
29 5. The system of claim 4,  
30 wherein the importing means further comprises means  
31 for transferring data over a secure protocol.

32  
33 6. The system of claim 2,

1 further comprising means for using the CCR data to  
2 Register Vendors, Search and Select Vendors for  
3 solicitation of services and/or delivery of supplies;  
4 View Vendor Profile;  
5 Search Vendor Profile; or  
6 Electronically Transfer Funds for outstanding  
7 account payable.  
8

9 9. The system of claim 6,  
10 wherein the search vendor profile further comprises  
11 means for receiving as a search parameter one or more of  
12 the following:

13 Business Name;  
14 DUNS and CAGE Code;  
15 Socio Economic Factors;  
16 Business Type;  
17 Geographic Location; and  
18 NAICS/SIC Code.  
19

20 10. The system of claim 6, further comprising:

- 21 [1] means for retrieving CCR public data and private data;  
22 [2] means for determining the vendor's business name and  
23 mailing address from the public data;  
24 [3] means for determining the vendor's electronic fund  
25 transfer (EFT) information from the private data; and  
26 [4] means for using the EFT information to pay the vendor.  
27

28 This appeal arises from the Examiner's Final Rejection, mailed May  
29 26, 2006. The Appellants filed an Appeal Brief in support of the appeal on  
30 March 18, 2007. An Examiner's Answer to the Appeal Brief was mailed on  
31 July 19, 2007.

## 32 PRIOR ART

33 The Examiner relies upon the following prior art:

34 King	US 5,319,542	Jun. 7, 1994
35 McLauchlin	US 6,754,672 B1	Jun. 22, 2004
36 Goodman	US 2003/0088475 A1	May 8, 2003

1	Mascavage	US 2003/0126036 A1	Jul. 3, 2003
2	Gieselmann	US 2004/0117263 A1	Jun. 17, 2004
3	Byrne	US 2005/0060235 A2	Mar. 17, 2005
4			
5			

## REJECTIONS

Claims 1-2 and 11-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byrne and McLauchlin.

Claims 3-5 and 13-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King.

Claims 6-8 and 16-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and Gieselmann.

Claims 9 and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, and Goodman.

Claims 10 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage.

## ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-2 and 11-12 under 35 U.S.C. § 103(a) as unpatentable over Byrne and McLauchlin.
  - This issue turns on whether McLauchlin describes a Central Contact Registry (CCR) and whether it would have been obvious to combine Byrne and McLauchlin.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 3-5 and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King.

- This issue turns on whether King describes keeping a local database and whether King describes a means for importing CCR data into public and private data storage.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 6-8 and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and Gieselmann.
  - This issue turns on whether Gieselmann describes using the CCR data as claimed.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 9 and 19 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, and Goodman.
  - This issue turns on whether the Appellants have sustained their burden of showing the Examiner erred in rejecting claims 1 and 11.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 10 and 20 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage.
  - This issue turns on whether the cited references describe a means for retrieving CCR public and private data.

## FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*King*

1           01. King is directed towards a method and system for facilitating  
2           the ordering of items from suppliers (column 1, lines 6-10).

3           02. King describes the ability for users of the system to create a  
4           local (private) catalog (database) from the public database on their  
5           own local computer system (column 3, lines 50-58 and column 4,  
6           lines 15-20). A master catalog is maintained by the supplier and  
7           the information from the master catalog is transmitted to the  
8           public and private catalogs (column 3, lines 63-67). A supplier  
9           can set-up a profile which includes business information such as  
10          supplier name, number, and address. The private catalog is  
11          periodically updated from the public catalog (column 4, lines 3-  
12          33). Access to the catalogs is secure in that only authorized users  
13          are enabled to access the catalogs (column 5, lines 10-13).

14          *McLauchlin*

15          03. McLauchlin is directed towards a system for integrating  
16          enterprise wide systems (column 1, lines 15-20).

17          04. McLauchlin describes the past federal systems to be a  
18          collection of separated systems (column 1, lines 38-43) and a  
19          purchasing agent would need to look up vendor data stored in the  
20          CCR system for additional vendor details and in order to pay the  
21          vendor (column 1, lines 57-65).

22          *Goodman*

23          05. Goodman is directed towards a method for conducting,  
24          tracking, and promoting internet commerce via a virtual retail  
25          outlet (paragraph 0002).

1           06. Goodman describes a vendor can be found by searching a  
2           vendor database by values such as vendor ID, vendor password,  
3           vendor name, address, city, state, postal code, contact phone  
4           number, fax number, email address, or the percentage net due  
5           (paragraph 0061).

6           *Mascavage*

7           07. Mascavage is directed towards a method of making an online  
8           purchase using a payment system (paragraph 0003).

9           08. Mascavage describes transferring funds, via the transfer server,  
10          between the user and FTS accounts and then between the FTS  
11          accounts and merchants (paragraph 0033). The transfer server  
12          minimizes the transfer of private information while conducting  
13          transactions (paragraph 0040), which is done by requiring  
14          authorization and authentication (paragraph 0028) and through the  
15          use of encryption and digital signatures (paragraph 0041).

16          *Gieselmann*

17          09. Gieselmann is directed towards a procurement system which  
18          enables a plurality of users within a purchasing organization to  
19          procure goods/services from an on-line marketplace (paragraph  
20          0001).

21          10. Gieselmann describes an initial registration process of a  
22          company (paragraph 0054). An employee of the company  
23          accesses the on-line marketplace and submits a request to register  
24          (paragraph 0054). The system prompts the user to enter company  
25          specific information (paragraph 0054). The user can enter the



VAT-Number of the company as a unique identifier or the DUNS-  
Number of the company (paragraph 0054).

11. Gieselmann is solves the problem of automating the registration  
process by eliminating the need of dedicated in-house computer  
resources at the customer-site (paragraph 0014).

*Byrne*

12. Byrne is directed to a method to integrate the coordination of  
suppliers, buyers, carriers, and service providers of goods/services  
with respect to a customer (paragraph 0001).

13. Byrne describes a networked system that receives purchase  
orders (paragraphs 0040 and 0052).

14. Buyers are enabled to submit integrated orders, where a single  
order contains multi-product, multi-supplier, multi-carrier, multi-  
service provider, and/or multi-sub orders (paragraph 0027).

15. When a buyer submits an order, multiple orders are submitted  
to multiple appropriate suppliers to fulfill the order (paragraph  
46).

16. Suppliers acknowledge receipt of the order and the ability to  
fulfill the order (paragraph 0052).

*Facts Related To The Level Of Skill In The Art*

17. Neither the Examiner nor the Appellants has addressed the level  
of ordinary skill in the pertinent art of online procurement  
systems. We will therefore consider the cited prior art as  
representative of the level of ordinary skill in the art. *See Okajima*  
*v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he  
absence of specific findings on the level of skill in the art does not

1           give rise to reversible error ‘where the prior art itself reflects an  
2           appropriate level and a need for testimony is not shown’”)  
3           (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755  
4           F.2d 158, 163 (Fed. Cir. 1985)).

5           *Facts Related To Secondary Considerations*

6           18. There is no evidence on record of secondary considerations of  
7           non-obviousness for our consideration.

8  
9           PRINCIPLES OF LAW

10          *Obviousness*

11          A claimed invention is unpatentable if the differences between it and  
12          the prior art are “such that the subject matter as a whole would have been  
13          obvious at the time the invention was made to a person having ordinary skill  
14          in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.  
15          Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14  
16          (1966).

17          In *Graham*, the Court held that that the obviousness analysis is  
18          bottomed on several basic factual inquiries: “[ (1) ] the scope and content of  
19          the prior art are to be determined; [ (2) ] differences between the prior art and  
20          the claims at issue are to be ascertained; and [ (3) ] the level of ordinary skill  
21          in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*  
22          *Inc.*, 127 S. Ct. at 1734. “The combination of familiar elements according to  
23          known methods is likely to be obvious when it does no more than yield  
24          predictable results.” *KSR*, at 1739.

25          “When a work is available in one field of endeavor, design incentives  
26          and other market forces can prompt variations of it, either in the same field

1 or a different one. If a person of ordinary skill can implement a predictable  
2 variation, § 103 likely bars its patentability.” *Id.* at 1740.

3 “For the same reason, if a technique has been used to improve one  
4 device, and a person of ordinary skill in the art would recognize that it would  
5 improve similar devices in the same way, using the technique is obvious  
6 unless its actual application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field  
8 of endeavor at the time of invention and addressed by the patent can provide  
9 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

10 *Automation of a Known Process*

11 It is generally obvious to automate a known manual procedure or  
12 mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*  
13 *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary  
14 skill in the art would have found it obvious to combine an old  
15 electromechanical device with electronic circuitry

16 to update it using modern electronic components in  
17 order to gain the commonly understood benefits of  
18 such adaptation, such as decreased size, increased  
19 reliability, simplified operation, and reduced cost  
20 . . . . The combination is thus the adaptation of an  
21 old idea or invention . . . using newer technology  
22 that is commonly available and understood in the  
23 art.

24  
25 *Id.* at 1162.

ANALYSIS<sup>2</sup>

*Claims 1-2 and 11-12 rejected under 35 U.S.C. § 103(a) as unpatentable  
over Byrne and McLauchlin*

The Appellants argue these claims as a group.

Accordingly, we select claim 1 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Byrne describes all of the limitations of claim 1 except for “accessing a Central Contract Registry (CCR) for supplier data” and “paying the suppliers based on CCR data” (Answer Pages 12-13). The Examiner found McLauchlin describes these limitations and one of ordinary skill in the art would have known to combine McLauchlin and Byrne in order to increase the system’s interfacing capabilities (Answer Page 13).

The Appellants contend (1) Byrne and McLauchlin fail to describe automatically using a Central Contact Registry (CCR) data for processing and payment and (2) it would not be obvious to modify Byrne because McLauchlin teaches away from the claimed invention and there is no reasonable expectation of success in combining Byrne and McLauchlin.

The Appellants first contend (1) Byrne and McLauchlin fail to describe automatically using Central Contact Registry (CCR) data for processing and payment. We disagree with the Appellants. The Appellants specifically contend that the claimed invention is different from the Byrne and McLauchlin combination because the combination merely results in an

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<sup>2</sup> We note that the Examiner has withdrawn the previously asserted rejections to claims 9 and 19 as failing to comply with 35 U.S.C. § 112, second paragraph (Answer Page 4).

1 end user having access to the plurality of systems to perform the tasks of  
2 creating sub-orders for vendors, whereas the claimed invention  
3 automatically uses CCR data for processing and payment.

4       This argument fails from the onset because it is based on limitations  
5 not appearing in the claims. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).  
6 There is no limitation found in the claims that requires any of the steps be  
7 automated. Furthermore, since the Appellants concede that the Byrne and  
8 McLauchlin combination describe the manual performance of the processing  
9 and payment (Br. Page 7, first and second paragraphs), the issue turns on  
10 whether it would have been obvious to perform these steps *automatically*.  
11 We find that it is generally obvious to automate a known manual process.  
12 *Leapfrog*, 485 F.3d at 1163. The mere automation of this known manual  
13 process is the adaptation of an old idea or invention using newer technology  
14 that is commonly available and understood in the art and therefore obvious.

15       The Appellants additionally contend (2) it would not be obvious to  
16 modify Byrne because McLauchlin teaches away from the claimed invention  
17 and there is no reasonable expectation of success in combining Byrne and  
18 McLauchlin. We disagree with the Appellants. The Appellants specifically  
19 argue that McLauchlin teaches away from the present invention because  
20 McLauchlin teaches human viewing of CCR data and not automated  
21 processing of CCR data to order and pay vendors. As discussed above,  
22 McLauchlin describes a purchasing agent viewing CCR data and using the  
23 CCR data to pay vendors (FF 04). This describes the manual steps of the  
24 claimed invention. Automation of these steps is obvious as found in  
25 *Leapfrog*. Since McLauchlin is directly teaching manual steps of the

1 claimed invention, the Appellants' contention that McLauchlin is teaching  
2 away from the claimed invention is not persuasive.

3 With respect to the Appellants' contention that there is no reasonable  
4 expectation of success in combining Byrne and McLauchlin, we disagree.  
5 Byrne describes a system that handles the submission of orders and the  
6 generation of sub-orders to multiple suppliers from the order (FF 14).  
7 McLauchlin describes a system that provides supplier details (FF 04) which  
8 expedites the processing of orders by keeping vendor information on-hand.  
9 Since both references are concerned with the purchase of goods and the  
10 routing of orders to vendors, one of ordinary skill in the art would have  
11 looked to McLauchlin from Byrne in order to increase the efficiency of the  
12 system at the time of the invention and one would have a reasonable  
13 expectation of success in combining Byrne and McLauchlin.

14 The Appellants have not sustained their burden of showing that the  
15 Examiner erred in rejecting claims 1-2 and 11-12 under 35 U.S.C. § 103(a)  
16 as unpatentable over Byrne and McLauchlin for the above reasons.

17  
18 *Claims 3-5 and 13-15 rejected under 35 U.S.C. § 103(a) as unpatentable*  
19 *over Byrne, McLauchlin, and King*

20 The Examiner found that the combination of Byrne and McLauchlin  
21 describe all of the limitations of claims 3 and 4 except "keeping a local copy  
22 of the CCR database in a system database" (Answer Page 14) and  
23 "importing the CCR data into a public data storage and a private data  
24 storage" (Answer Page 15). The Examiner found that King describes this  
25 limitation (Answer Page 14) and one of ordinary skill in the art would have

1 known to combine King with Byrne and McLauchlin in order to provide a  
2 reduction of customer maintenance of their private data (Answer Pages 14-  
3 15).

4       The Appellants contend that (1) King fails to describe “keeping a  
5 local copy of the CCR database in a system database” as per claim 3, (2)  
6 King fails to describe “importing the CCR data into a public data storage  
7 and a private data storage” as per claim 4, and (3) claim 5 is allowable for  
8 the same reasons asserted for claim 1.

9       The Appellants first contend (1) King fails to describe “keeping a  
10 local copy of the CCR database in a system database” as per claim 3.  
11 McLauchlin describes the use of a CCR database (FF 02). King describes a  
12 public catalog requisition system where users are enabled to maintain a local  
13 private copy of the public and master catalogs (FF 02). As such, King  
14 explicitly describes claim 3. Claim 13 recites the same limitations and is  
15 described by King for the same reason discussed above.

16       The Appellants further contend (2) King fails to describe “importing  
17 the CCR data into a public storage data and a private data storage” as per  
18 claim 4. The Appellants specifically argue that King is inconsistent with one  
19 implementation discussed on pages 16-17 of the Specification. We agree  
20 with the Appellants. Claim 4 is drafted using means-plus-function language.  
21 In construing means-plus-function claim language in accordance with 35  
22 U.S.C. § 112, sixth paragraph, one must “look to the specification and  
23 interpret that language in light of the corresponding structure, material, or  
24 acts described therein, and equivalents thereof, to the extent that the  
25 specification provides such disclosure. *In re Donaldson Co.*, 16 F.3d 1189,  
26 1193 (Fed. Cir. 1994). The specification describes that the data is separated

1 into a CCR public file and a CCR private data file in the system database  
2 (Specification Page 15). As such, the data is separated in to two distinct  
3 files by a device or structure. Although King describes the use of importing  
4 data from the master catalog into public and private catalogs (FF 02), King  
5 fails to describe a device that separates the data into public and private data.  
6 As such, the Appellants have sustained their burden of showing the  
7 Examiner erred in rejecting claim 4.

8 The Appellants additionally contend (3) claim 5 is allowable for the  
9 same reasons asserted for claim 1. Claim 5 is dependant on claim 4. We  
10 found the Appellants did sustain their burden of showing the Examiner erred  
11 in rejecting claim 4 and as such find that the Appellants have sustained their  
12 burden of showing the Examiner erred in rejecting claim 5.

13 Claims 14 and 15 are distinguished from claims 4 and 5 in that they  
14 do not recite the requisite means-plus-function language to invoke 35 U.S.C.  
15 § 112, sixth paragraph. Under this light, King discloses the subject matter of  
16 claim 14 by describing the importing of the master catalog into public and  
17 private catalogs (FF 02). There is no further limitation recited by claim 14  
18 that requires the public and private data not to overlap, as was required by  
19 the means plus function construction of claim 4. King further describes that  
20 only authorized users can direct the transmitting of data between the master,  
21 public, and private catalogs (FF 02) which is a secure protocol, as recited by  
22 claim 15.

23 The Appellants have sustained their burden of showing that the  
24 Examiner erred in rejecting claims 4-5 under 35 U.S.C. § 103(a) as  
25 unpatentable over Byrne, McLauchlin, and King for the above reasons.



The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 3 and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King for the above reasons.

*Claims 6-8 and 16-18 rejected under 35 U.S.C. § 103(a) as unpatentable  
over Byrne, McLauchlin, and Gieselmann*

The Appellants argue these claims as a group.

Accordingly, we select claim 6 as representative of the group.

The Examiner found that the combination of Byrne and McLauchlin describe all of the limitations of claim 2 but fail to describe the additional limitation claimed in claim 6 (Answer Page 17). The Examiner found that Gieselmann describes this limitation and one of ordinary skill in the art would have known to combine Gieselmann, Byrne, and McLauchlin in order to provide registration that does not require dedicated in-house computer resources (Answer Page 17).

The Appellants contend that Gieselmann fails to describe the means of using the claimed CCR data as the claimed CCR contains information not available in DUNS. We disagree with the Appellants. Gieselmann describes the CCR information is used to register vendors. This is done by entering the DUNS-Number into the CCR information during registration (FF 10), which mirrors the claimed invention (Specification Page 15). Additionally, McLauchlin describes using CCR data to enable a user to view vendor profile information (FF 04).

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 6-8 and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and Gieselmann for the above reasons.

1        *Claims 9 and 19 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
2                    *Byrne, McLauchlin, Gieselmann, and Goodman*

3        The Appellants argue these claims as a group.

4        Accordingly, we select claim 9 as representative of the group.

5        The Examiner found that Byrne, McLauchlin, and Gieselmann  
6 describes all of the limitations of claim 6, but fail to describe the additional  
7 limitation presented in claim 9 (Answer Page 19). The Examiner found that  
8 Goodman describes this limitation and one of ordinary skill in the art would  
9 have known to combine Goodman to Byrne, McLauchlin, and Gieselmann  
10 in order to provide a convenient way to find a vendor (Answer Page 19).

11       The Appellants contend that the references fail to describe the  
12 limitations of claims 1 and 11 as argued above. The Appellants rely on  
13 arguments in support of claims 1 and 11 above, which we found to be  
14 insufficient to overcome the Appellants' burden and so the Appellants have  
15 not sustained its burden of showing that the Examiner erred in rejecting  
16 claims 9 and 19 under 35 U.S.C. § 103(a) as unpatentable over Byrne,  
17 McLauchlin, Gieselmann, and Goodman.

18  
19       *Claims 10 and 20 rejected under 35 U.S.C. § 103(a) as unpatentable*  
20                    *over Byrne, McLauchlin, Gieselmann, King and Muscavage*

21       The Appellants argue these claims as a group.

22       Accordingly, we select claim 10 as representative of the group.

23       The Examiner found that Byrne, McLauchlin, and Gieselmann  
24 describe all of the limitations of claim 6, but fail to describe the additional  
25 limitations of claim 10 (Answer Page 20). The Examiner found that King  
26 describes limitation [1] and limitation [2] and one of ordinary skill in the art

1 would have known to combine King with Byrne, McLauchlin, and  
2 Gieselmann in order to provide a reduction of customer maintenance of their  
3 private data (Answer Pages 20-21). The Examiner further found that  
4 Muscavage describes limitation [3] and limitation [4] and one of ordinary  
5 skill in the art would have known to combine Muscavage with Byrne,  
6 McLauchlin, Gieselmann, and King in order to provide a secure way to  
7 transfer funds in ecommerce (Answer Page 21).

8 The Appellants contend (1) the combination of the references do not  
9 provide the specific claimed structures of “means for retrieving CCR public  
10 data and private data,” “means for determining the vendor’s business name  
11 and mailing address from the public data,” “means for determining the  
12 vendor’s electronic fund transfer (EFT) information from the private data,”  
13 and “means for using the EFT information to pay the vendor” and (2) that  
14 the Examiner used impermissible hindsight reconstruction of the present  
15 invention in combining the references and there was no reasonable  
16 expectation of success when combining the references.

17 We agree with the Appellants with respect to claim 10, but disagree  
18 with the Appellants with respect to claim 20. Claim 10 recites means plus  
19 function limitations and thus we must look to the Specification for a  
20 corresponding structure. As we found with claim 4, the Specification  
21 describes that the data is separated into a CCR public file and a CCR private  
22 data file in the system database (Specification Page 15). None of the cited  
23 references describe a corresponding structure that performs this step. As  
24 such, we find that the Appellants have sustained their burden of showing that  
25 the Examiner erred in rejecting claim 10.

1           With respect to claim 20, we disagree with the Appellants. Claim 20  
2 is distinguished from claim 10 in that it does not recite the requisite means  
3 plus function limitation to invoke 35 U.S.C. § 112, sixth paragraph. King  
4 describes the use of public and private catalogs for supplier's information  
5 (FF 02), which is the same as using CCR data. There is no further limitation  
6 recited by claim 20 that requires the public and private data to not overlap,  
7 as was required by the means plus function construction of claim 10. King  
8 further describes that the supplier can set up a profile to include business  
9 information such as the business name and mailing address (FF 02).  
10 Muscavage describes determining an electronic funds account for a  
11 merchant and paying a vendor by transferring funds using a transfer server  
12 (FF 08). Thus, the additional limitations of claim 20 are described by the  
13 cited references and the Appellants' argument is not found to be persuasive.

14           The Appellants further contend (2) that the Examiner used  
15 impermissible hindsight reconstruction of the present invention in  
16 combining the references and there was no reasonable expectation of success  
17 when combining the references. We disagree with the Appellants. It must  
18 be recognized that any judgment on obviousness is in a sense necessarily a  
19 reconstruction based upon hindsight reasoning. But so long as it takes into  
20 account only knowledge which was within the level of ordinary skill at the  
21 time the claimed invention was made, and does not include knowledge  
22 gleaned only from the applicant's disclosure, such a reconstruction is proper.  
23 *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Here, the Examiner  
24 found that, at the time of the invention, one of ordinary skill in the art would  
25 have looked to King to provide increase efficiency by reducing maintenance  
26 of data by enabling the retrieval of public and private data to determine the

1 name and address of a vendor (Answer Pages 20-21). The Examiner also  
2 found that, at the time of invention, one of ordinary skill in the art would  
3 have looked to Muscavage in order to increase the security of the system by  
4 determining a vendor's electronic funds information and paying the vendor  
5 using this electronic funds information (Answer Page 21). As such, the  
6 Examiner only relied on knowledge within ordinary skill in the art at the  
7 time of the invention and did not use impermissible hindsight reconstruction  
8 in rejecting claims 10 and 20. Furthermore, one of ordinary skill in the art  
9 would have had a reasonable expectation of success in combining King and  
10 Muscavage with Byrne, McLauchlin, and Giesermann because of the known  
11 benefits of increasing efficiency and security provided by King and  
12 Muscavage respectively.

13 The Appellants have sustained their burden of showing that the  
14 Examiner erred in rejecting claim 10 under 35 U.S.C. § 103(a) as  
15 unpatentable over Byrne, McLauchlin, Giesermann, King, and Muscavage  
16 for the above reasons.

17 The Appellants have not sustained their burden of showing that the  
18 Examiner erred in rejecting claim 20 under 35 U.S.C. § 103(a) as  
19 unpatentable over Byrne, McLauchlin, Giesermann, King, and Muscavage  
20 for the above reasons.

## 21 22 CONCLUSIONS OF LAW

23 The Appellants have not sustained their burden of showing that the  
24 Examiner erred in rejecting claims 1-2 and 11-12 under 35 U.S.C. § 103(a)  
25 as unpatentable over Byrne and McLauchlin.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 3 and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 6-8 and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and Gieselmann.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 9 and 19 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, and Goodman.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 10 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claim 20 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage.

## DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-2 and 11-12 under 35 U.S.C. § 103(a) as unpatentable over Byrne and McLauchlin is sustained.
- The rejection of claims 3 and 13-15 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King is sustained.

- The rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and King is not sustained.
- The rejection of claims 6-8 and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, and Gieselmann is sustained.
- The rejection of claims 9 and 19 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, and Goodman is sustained.
- The rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage is not sustained.
- The rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Byrne, McLauchlin, Gieselmann, King, and Muscavage is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

## hh

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